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EXAMINER

HUA, LY

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 05/21/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

2

Office Action Summary

Application No.

09/994,586

Applicant(s)

FRENCH ET AL.

Examiner

Ly V. Hua

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-69 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 39-69 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6.7</u> . | 6) <input type="checkbox"/> Other: ____. |

Detailed Office Action

Claim Rejections - 35 USC § 112, First Paragraph

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:
a. The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
Claims 39-62 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the invention(s), at the time the application was filed, had possession of the claimed invention.
2.
 - a. With regard to claim 39 (and thus its dependent claims 40-62):
i. In Claim 39 (and thus also in its dependent Claims 40-52), there is a step of (c) allowing the user to access a predetermined functionality, in real time, only if the user's identity is authenticated. However, the specification does not describe any such "predetermined functionality" term. The applicant is to be consistent with terminology used in claim and those in the specification.
 - b. With regard to claims 47, 48 and 53:
i. Each of the claims 47, 48, 53, refers to the method of claim 39, and calls for the predetermined functionality recited in claim 39, but such predetermined functionality has not been described in the specification.
 - c. With regard to claims 40-45, 49-52 and 54-62:
i. These claims depend on claim 39, and thus inherit the above problem from claim 39.
 - d. With regard to claim 39:
i. The formulating and presenting step is said to be based on the first type of information received and on credit related information, but it is not clear how the first type of information is based in order to formulate the query.
 - e. With regard to claims 40-62:
i. These claims depend on claim 39 and thus inherit the problem of indefiniteness therefrom.
 - f. With regard to claim 40:
i. The clause "step (c) is the only indication..." is not idiomatic. Notice that it is not clear how a step can be an indication.
 - g. With regard to claim 57:
i. The phrase "The level of correspondence determined in step (f)(iii) lacks antecedent basis."
ii. The phrase "The evaluation made in step (d)(i) also lacks antecedent basis."
 - h. With regard to claim 58:
i. This claim recite a step of obtaining a first result from step (f)(iii), but such step (f)(iii) have not been performed, and thus the result cannot be obtained and the step cannot be carried out. The claim thus cannot be understood. The applicant is to check for errors in the recitation of this claim that cause this problem.
 - i. With regard to claim 63:
i. The term "third party" has been used without a usage of phrases such as "first party" or "second party", making it not clear as to who is the third party as relative to a first or second party (if there is any such first or second party).
ii. That which is about the user's identity that is being indicated by the indication provided to the third party is not clear.
 - j. With regard to claims 64 and 65:
i. These claims depend on claim 63 and thus inherit the problem of indefiniteness therefrom.
 - k. With regard to claim 66:
i. That which is about the user's identity that is being indicated by the indication provided by the processor is not clear.
 - l. With regard to claims 67 and 69:
i. These claims depend on claim 66 and thus inherit the problem of indefiniteness therefrom.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Long*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 39-69 of the present application are rejected under the judicially created doctrine of double patenting over claims 1-54 of U. S. Patent No. 6,321,339 since the claims of the present application, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: Please see the tables below.

- Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Scheller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

5. Claim 39 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,321,339. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reason as can be seen in the following two columns.

a. Claim 39 claims a method for authenticating	b. Claim 1 of Patent (6,321,339) is claims a method for authenticating
<p>i. for authenticating a user's identity interactively (see "interactive" in claim 10)</p> <p>ii. wherein the method checks a user's information against a credit file, the method comprising:</p> <p>(1) receiving from the user a first type of information wherein the first type of information is wallet type information;</p> <p>(2) formulating and presenting to the user, in real time, a query based on the first type of information received and upon information located in a credit file, the credit file containing credit-related information from a plurality of the user's creditors;</p> <p>(3) receiving a response to the query from the user in real time;</p> <p>(4) comparing the response to information in the user's credit file, in real time, to authenticate the user's identity; and</p> <p>(5) allowing the user to access a predetermined functionality, in real time, only if the user's identity is authenticated.</p>	<p>i. for authenticating a user's identity interactively (see "interactive" in claim 10)</p> <p>ii. wherein the method checks (by performing a first authentication step and performing a second authentication step) a user's information (i.e., the first type of information and the second type of information) against a credit file (see "credit file" in claim 3), the method comprising:</p> <p>(a) receiving (see claim 1, step "a") a first type of information from the user, wherein the first type of information is wallet type information (see claim 41);</p> <p>(b) formulating and presenting (see claim 8) to the user, in real time, a query based on the first type of information received [since the formulating and presenting step would not come to pass if the first type of information have not been both received and processed], and upon information located in a credit file, the credit file containing credit-related information (see claim 8, step iv, for "credit-related information") from a plurality of the user's creditors;</p> <p>(c) receiving (inherent between step v and step vi of claim 8) a response from the user in real time;</p> <p>(d) comparing (see claim 8 for the term "evaluating" (which evaluating is a comparing) the response to information in the user's credit file in real time, to authenticate the user's identity [see claim 9 user's identity is being authenticated by step the comparing/evaluating step]; and</p> <p>(e) allowing the user to access a predetermined functionality [see the patent's claim 1, step c, for issuing of digital certificate if the user's identity is authenticated], only if the user's identity is authenticated.</p> <p>iv. With regard to the "in real time" limitation recited the claims of the present application, Patent 6,321,339 specified (a) Detailed Description Text - paragraph 111) that: the user inputs the first type of information requested into client 110. Data may be queried from the user through textual questions, graphical user interfaces (GUIs), hypertext markup (HTML) forms or any other suitable mechanisms, either in a real-time interactive environment or through a batch submission. Selection of the input mode may depend upon various factors such as resource loading and availability, business model, user and system traffic and transaction criticality.</p>

<p>6. Claim 40 claims that in the method of claim 39,</p> <p>a. step (e) is (1) the only indication received by the user (a) regarding (i) correctness of 1) the first type of information and 2) the response provided by the user.</p>	<p>7. Claim 1 of the patent does issue a digital certificate needed by the user, which issuing of the digital certificate is as readily understood by a person having ordinary skill in the art, allowing the user to access to certain place/service/functionality/operation.</p>
<p>8. Claim 46 claims that the method of claim 39, wherein</p> <p>a. the user provides (1) the first type of information and the response from a platform (2) located remotely from the credit file.</p>	<p>9. Claim 1 of the patent recite the user, who is not said to be at the recited credit file, but is described as a user remotely located from the authentication system and the credit database.</p>
<p>10. Claims 47, 48, 53 claim that in the method of claim 39, the predetermined functionality is:</p> <p>a. 47. provided by a platform other than the creditor of the user or the credit file;</p> <p>b. 48. The method of claim 39, wherein the predetermined functionality is provided by a party other than the credit file's owner, OK</p> <p>c. 53. The method of claim 39, wherein the predetermined functionality is issuance of a digital certificate.</p>	<p>11. Claim 1 of the patent covers the limitation in each of present application's claims 47, 48, 53 in that Claim 1 of the patent claim that the issuance of a digital certificate (which issuance is "the predetermined functionality" since "is" here is a linking verb) is issued by the method (performed by a system for authenticating). The authenticating system, which is in the claim of the patent and which does the authentication and issuing the certificate, is neither the creditor of the user or of the credit file (or the credit file's owner) since the authenticating system obtains the information it needs from the creditor (or from the credit file owner).</p>
<p>12. Claim 49 claims that in the method of claim 39 steps (a), (b), (c), (d), and (e) are executed sequentially.</p>	<p>13. The examiner asserts that the steps in claim 1 of patent 6,321,339 that are corresponding to the steps (a), (b), (c), (d), and (e) of claim 39 of the present application are likewise being executed sequentially as those of the method of claim 39. [See the sequence at which the steps in claims 1, 2 and 8 of the patent are recited].</p>
<p>14. Claim 62 claims that the method of claim 39 further comprising:</p> <p>a. (1) performing a fraud check (1) to detect a fraudulent attempt to authenticate by the user.</p>	<p>15. Patent 6,321,339 described [see Detailed Description Text, paragraph 74] the invention therein with the following text:</p> <p>a. If the request is identified as a result of the association check 24 or other analysis as possibly fraudulent using the association check or otherwise, a message may be returned to client 110 indicating that the request cannot be processed automatically and that manual processing such as calling customer service is necessary.</p>

<p>16. Claim 44 of the present application claims that in the method of claim 39, step (b)'s query is in a multiple-choice format.</p>	<p>17. The limitation in claim 44 of the present application (i.e., step (b)'s query is in a multiple-choice format) is covered by claim 1 of the patent in that claim 1 of the patent is described and claimed as seen in claim 11 that claims that the method of claim 10, wherein the interactive query comprises at least one question having multiple choice answers.</p>
<p>18. Claims 45 and 41 are recited as follow: a. 45. The method of claim 44, wherein step (b) is repeated a plurality of times. b. 41. The method of claim 39, wherein steps (b) and (c) are repeated multiple times.</p>	<p>19. The repetitions of the steps) as recited in claim 45 and 41 have been covered by the method of claim 1 of the patent, since they are disclosed by the patent and could have been presented in the claims of the patent. a. The Patent's Detailed Description Text, paragraph 81st specified: 1. Authentication process 10 determines whether a request for information has been repeated more than a predetermined number of times at step 42. If the attempt exceeds the predetermined limit, authentication process 10 ends at step 44. If the attempt does not exceed the predetermined limit, authentication process 10 determines whether step 40 is complete at step 46. If step 40 is complete, authentication process 10 renders an authentication decision at step 48, then ends at step 50. If step 40 is not complete, authentication process may return to step 38 or end at step 47.</p>
<p>20. Claims 42 and 43 claims that in the method of claim 41 a plurality of queries are presented in a. 42. a single display to the user. b. 43. a plurality of displays to the user.</p>	<p>21. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to present a display of a plurality of queries to a user either together in a single display or separately in a plurality of displays.</p>

<p>22. Claim 50 claims that the method of claim 39 further comprising: a. verifying the first type of information received.</p>	<p>23. Claim 1 of patent 6,321,339 has covered the verifying of the first type of information received recited in claim 22 of the present application because: a. Claim 1 of the patent recites: i. receiving the first type of information from the user, wherein the first type of information is identification information, and processing the identification information, which processing is further detailed in claim 2 to have the steps of: (1) (a) retrieving user information from a data source; and (b) determining a level of correspondence between the identification information supplied by the user and the user information retrieved from the data source.</p>
<p>24. Claim 51 claims that in the method of claim 50, a. step (i) is executed after step (a) and, b. if step (i) is successful, step (b) is executed.</p>	<p>25. Claim 1 of patent 6,321,339 has covered the sequence at which step (i) of claim 22 of the present application is executed and the condition for which step (b) of claim 39 of the present application is executed because: a. Claim 1 of the patent recites the following in sequence: i. performing a first authentication step based on a first type of information by receiving the first type of information from the user, wherein the first type of information is identification information, and processing the identification information; ii. performing at least a second authentication step based on a second type of information other than the first type of user identification information by retrieving the second type of information from a credit reporting company's credit database, wherein the second type of information is user credit related information compiled from a plurality of sources, and (2) i) querying the user regarding the credit related information; and ii) if steps (a) and (b) authenticate the user, issuing a digital certificate; b. Claim 1 of the patent is also further detailed by claim 14 of the patent that: i. the processing of the first type of information determines: ii. that the user can be authenticated, and iii. that the second authentication step should be performed.</p>

<p>26. Claim 52 claims that in the method of claim 50, wherein</p> <p>a. verifying the first type of information further comprises</p> <p>i. preprocessing</p> <p>(1) at least some information from the first type of information for reliability,</p> <p>(2) including performing at least one task selected from the group of tasks consisting of</p> <p>(a) checking</p> <p>(b) comparing the at least some information against a record of known data, and</p> <p>(c) ensuring that the at least some information is present in the record of known data.</p>	<p>27. Claim 1 of patent 6,321,339 has covered the limitations recited in claim 52 of the present application because:</p> <p>a. Claim 1 of the patent recites:</p> <p>i. processing the identification information (which identification information is the first type of information), which processing</p> <p>(a) comprises at least one of (as further detailed by the recitation of claims 12 and 13 of the patent):</p> <p>(i) standardizing at least one field of information;</p> <p>(ii) formatting at least one field of information;</p> <p>(iii) checking internal consistency between at least two fields of information; and</p> <p>(iv) checking the validity of at least one field of information; and</p>
<p>28. Claim 54 claims that in the method of claim 50,</p> <p>a. step (f) comprises:</p> <p>i. retrieving the user's identification information</p> <p>(1) from a data source;</p> <p>ii. comparing the first type of information received with the user identification information retrieved from the data source; and</p> <p>iii. determining a level of correspondence between</p> <p>(a) the first type of information received and the user identification information retrieved from the data source.</p>	<p>29. Claim 1 of patent 6,321,339 has covered the limitations recited in claim 54 of the present application because:</p> <p>a. claim 1 of the patent is further detailed by the recitation of claim 2 as:</p> <p>i. The method of claim 1, wherein step (a) further comprises:</p> <p>(1) retrieving user information from a data source; and</p> <p>(iv) determining a level of correspondence between the identification information supplied by the user and the user information retrieved from the data source.</p>
<p>30. Claim 55 claims that in the method of claim 54, the data source comprises a credit file.</p>	<p>31. Claim 1 of patent 6,321,339 has covered the limitations recited in claim 55 of the present application because:</p> <p>a. claim 1 of the patent is further detailed by the recitation of claim 3 that the data source comprises a credit file of the user.</p>
<p>32. Claim 61 claims that in the method of claim 50, step (f) further comprises:</p> <p>a. executing a pattern recognition process</p> <p>(1) to detect potential irregularities in the first type of information obtained from the user.</p>	<p>33. Claim 1 of patent 6,321,339 has covered the limitations recited in claim 61 of the present application because:</p> <p>a. claim 1 of the patent is further detailed by the recitation of claim 2 as:</p> <p>i. the method of claim 2, further comprising (b) executing a pattern recognition process to detect potential irregularities in the information supplied by the user.</p>
<p>34. Claim 56 claims that in the method of claim 39,</p> <p>a. step (d) {comparing the response to information in the user's credit file, in real time, to authenticate the user's identity} further comprises:</p> <p>i. retrieving the user's information</p> <p>(1) from the credit file; and</p> <p>ii. determining a level of correspondence between</p> <p>(a) the user's information and the user's credit file; and</p>	<p>35. Claim 1 of patent 6,321,339 has covered the limitations recited in claim 56 of the present application because:</p> <p>a. claim 1 of the patent recites that:</p> <p>(1) retrieving second type of information (from a credit database compiled from a source (which source comprises a credit file (as detailed by claim 3 of the patent))) and</p> <p>b.i. the response received from the user is evaluated - (claim 8); and</p> <p>(b)(vi) the identity of the user is authenticated based on the level of correspondence determined in step (b)(v) - (claim 9).</p>

	(i) the response received and (ii) the user's information retrieved from the credit file.	
36. Claim 57 claims that in the method of claim 56, a. the identity of the user i. is authenticated (1) based on (a) the level of correspondence determined in step (f)(iii) and (b) the evaluation made in step (d)(ii).		37. Claim 1 of patent 6,321,339 has covered the limitations recited in claim 57 of the present application because: a. claim 1 of the patent is further detailed by claim 9 as: i. the method of claim 8, wherein (1) the identity of the user is authenticated based on (a) the level of correspondence determined in step (a)(v) and (b) the evaluation made in step (b)(v).
38. Claim 58 claims that the method of claim 57, further comprising a. obtaining i. a first result (1) from step (f)(iii) and ii. a second result (1) from step (d)(ii).		39. Claim 1 of patent 6,321,339 has covered the limitations recited in claim 58 of the present application because: a. claim 1 of the patent performs: i. a step of performing a first authentication (from which a first result must inherently be obtained) and ii. a step of performing a second authentication (from which a second result must inherently be obtained).
40. Claim 59 claims that the method of claim 58, further comprising: a. (k) issuing i. an authentication score, (1) wherein the authentication score depends on (a) at least the first result or (b) the second result.		41. Claim 1 of patent 6,321,339 has covered the limitations recited in claim 59 of the present application because: a. claim 1 of the patent list some of the steps that have been specifically disclosed in the specification with an open-ended word "comprising" in the preamble; b. the issuing of an authentication: i. is fully disclosed in the Detailed Description Text (paragraph 83) of the patent, reciting: (1) "the transaction record 112 (illustrated in FIGS. 13-16) initialized in step 22 is used throughout the authentication process 10 to keep track of user input and authentication results. After the appropriate queries have been processed and all results stored in the transaction record 112, the transaction record 112 is used to determine an authentication score with respect to the request. Step 56 calculates the total authentication score, and optionally, a score for each data source, data field, etc. The results are categorized as a big hit (B), a regular hit (R), a possible hit (P), or no hit (N) depending on results. Those results may then be combined with the results of second level authentication process 40 to determine an overall authenticity certainty score, as illustrated in FIGS. 25-28 and discussed below." ii. could have been recited in claim 1 of the patent (or in its dependent claims) and can be readily read into to such claim(s) of the patent.
42. Claim 60 claims that the method of claim 58, further comprising a. assigning i. a first weight to the first result and ii. a second weight to the second result.		43. Claim 60 is also rejected with the rationale similar to that of the rationale for rejecting claim 59. a. The patent, Drawings of FIGS. 23-28 illustrate an assignment of overall certainty scores from first and second level authentication results generated according to the invention, from highest to lowest, i. which assigning (1) could be readily recited in claim 1 of the patent, and (2) the examiner, hereby, read it into claim 1 of the patent since claim 1 of the patent is open-ended as indicated by the word "comprising" in the preamble.
44. <u>With regard to claim 63:</u> a. That which is about the user's identity that is being indicated by the indication provided by the providing step is not clear.		
45. Claim 63-65 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-27 of U.S. Patent No. 6,321,339. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:		

- a. **With regard to claim 63:**
 i. The subject matter recited in claim 63 of the present application is fully disclosed in the patent (6,321,339).
 ii. The allowance of this claim 63 would extend the rights to exclude already granted in claim 1 of the patent (5,321,339).
 iii. Claim 63 of the present application is fully disclosed in the patent and
 (1) is covered by the patent since the patent and the application are claiming common subject matter.
 (2) Thus, the controlling fact is that patent protection for the device, fully disclosed in and covered by the claims of the patent, would be extended by the allowance of the claims in the application.
 iv. Furthermore, there is no apparent reason why applicant was prevented from presenting the claim in the application for examination during the prosecution of the issued patent.
 v. The following two columns are listed for comparing claim 63 of the present application against claim 1 (and its dependent claims) of the patent.
 vi.

<p>(1) Claim 63 of the present application claims a method for interactively authenticating</p> <p>(a) in real time (i) an end user's identity (ii) for a third party (iii) after the third party has verified the end user's identity through use of a first type of information (iv) wherein the first type of information is wallet type information, the method uses credit related information, the method comprising:</p> <p>(i) receiving the first type of information; (ii) formulating and presenting, in real time, a query based on the first type of information and the end user's information retrieved from a credit file, the credit file containing credit-related information originating from a plurality of the end-user's creditors;</p> <p>(iii) receiving a response in real time; (iv) comparing</p>	<p>b. Claim 1 of Patent (6,321,339) is claims a method for authenticating,</p> <p>i. interactively (see "interactive" in claim 10) (1) in real time; (2) a user's identity; (3) wherein the method (1) checks (by performing a first authentication step and performing a second authentication step) a user's information (i.e., the first type of information and the second type of information) against a credit file (see "credit file" in claim 3), (b) the method comprising: (a) receiving (see claim 1, step "a") a first type of information from the user; (i) formulating and presenting (see claim 8) to the user, in real time, a query based on the first type of information received (since the formulating and presenting step would not come to pass if the first type of information have not been both received and processed); and (ii) upon information located in a credit file, the credit file containing credit-related information (see claim 8, step iv, for "credit-related information") from a plurality of the user's creditors; (c) receiving (inherent between step v and step vi of claim 8) a response from the user in real time; (d) comparing (see claim 8 for the term "evaluating" (which evaluating is a comparing) the response to information in the user's credit file in real time; (i) to authenticate the user's identity [see claim 9 user's identity is being authenticated by step of digital certificate if the user's identity is authenticated]; and (ii) allowing the user to access a predetermined functionality [see the patent's claim 1, step c, for issuing only if the user's identity is authenticated].</p>

<p>(v) the response, in real time, to information in the credit file; and</p> <p>(c) providing an indication about the end user's identity, in real time, to the third party.</p>	<p>c. With regard to the "in real time" limitation recited in the claims of the present application, Patent 6,321,339 specified (at Detailed Description Text - paragraph 11) that:</p> <p>i. the user inputs the first type of information requested into client 110. Data may be queried from the user through textual questions, graphical user interfaces (GUIs), hypertext markup (HTML) forms or any other suitable mechanisms, either in a real-time interactive environment or through a batch submission. Selection of the input mode may depend upon various factors such as resource loading and availability, business model, user and system traffic and transaction criticality.</p> <p>d. With regard to the step of providing an indication about the end user's identity to a third party, the examiner presents the following:</p> <p>(1) This limitation has not been claimed in the claims of the above-mentioned patent.</p> <p>(2) The method of Claim 1 of the patent is understood to be performed by authentication 120 in behalf of a resource 140. [See Figure 12].</p> <p>(3) It is understood from the detailed description of of Figure 12 that</p> <p>(a) only if the user's identity is authenticated, then the authentication server 120 allows the user to access a predetermined functionality (provided by the resources 140), in real time, which allowance is a decision that the authentication server 120 makes on behalf of the resource 140; and</p> <p>(ii) such decision must be made known to the resource 140; and</p> <p>(1) introduces that Reiche (US patent 6,092,196) teaches: that in an authentication server 110 that authenticates a customer 100 for a customer server 120, the authentication server 110 issues a status code to the customer server permitting release of a resource being sought by the customer who has been authenticated. [See Reiche's Brief Summary Text, paragraphs 47 and 53].</p> <p>e. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to realize that when one entity acting on behalf of another entity, the one entity must inform the another entity its state/finding/decision.</p> <p>f. The skilled person would have been motivated to have the method of claim 1 of patent 6,321,339 provides a resource/merchant/website/"customer server" an indication, after having authenticated the user's identity, that either the user should be permitted to or prevented from have access to certain functionality at the resource/merchant/website/"customer server" as requested by the user because:</p> <p>i. it is readily understood from reading the description of Figure 12 of patent 6,321,339; and</p> <p>ii. Reiche teaches such authentication-server's provision of an indication to the resource/merchant/website/"customer server" once a customer has been authenticated.</p>
<p>g. With regard to claim 64: i. The following two columns are listed for comparing claim 64 of the present application against claim 1 of the patent.</p> <p>(1) Claim 64 of the present application claims that the method of claim 63, wherein the query is in a multiple-choice format.</p>	<p>46. The limitation in claim 64 of the present application (i.e., the query form for and presented by the method is in a multiple-choice format) is covered by claim 1 of the patent in that claim 1 of the patent is described and claimed as seen in claim 11 that claims that the method of claim 10, wherein the interactive query comprises at least one question having multiple choice answers.</p>
<p>a. With regard to claim 65: i. The following two columns are listed for comparing claim 65 of the present application against claim 1 of the patent.</p> <p>(1) Claim 65 of the present application claims that the method of claim 63, wherein steps (b), (c), and (d) may repeat a plurality of times.</p>	<p>47. The repetitions of the step(s) as recited in claim 65 have been presented in the claims of claim 1 of the patent, since they are disclosed by the patent and could have been presented in the claims of the patent.</p> <p>a. The Patent's Detailed Description Text, paragraph 81st specified:</p> <p>i. Authentication process 10 determines whether request for information has been repeated more than a predetermined number of times at step 42. If the attempt exceeds the predetermined limit, authentication process 10 ends at step 44. If the attempt does not exceed the predetermined</p>

limit, authentication process 10 determines whether step 40 is complete at step 46. If step 40 is complete, authentication process 10 renders an authentication decision at step 48, then ends at step 50. If step 40 is not complete, authentication process may return to step 38 or end at step 47.

48. Claim 66-69 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 28-54 of U.S. Patent No. 6,321,339. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

a. With regard to claim 66:

i. The subject matter recited in claim 66 of the present application,

- (1) comprising
(a) an input interface,
(b) a credit database, and
(c) a processor

(i) which processor is to:

- 1) receive a first type of information from a user,
- 2) form a query based on the first type of information and present the query to the user,
- 3) receive a response from the user,
- 4) compare the response to information in the credit database, and
- 5) provide an indication about the user's identity,

(2) is fully disclosed in the patent (6,321,339).

ii. The allowance of this claim 66 would extend the rights to exclude already granted in claim 28 of the patent (5,321,339).

iii. Claim 28 of the patent (6,321,339),

- (1) claiming

- (a) a system for authenticating a user on a network,
(i) comprising
(ii) an input interface

1) for receiving

2) a credit database

a) from a credit reporting agency, and

3) a processor connected to the input interface and configured to:

a) perform a first authentication step

based on the identification information

by processing the identification information

perform at least a second authentication step

based on a second type of information other than the first type of information

by retrieving the second type of information from the credit database,

wherein the second type of information is the user credit related information compiled from a plurality of sources; and

determine whether to issue a digital certificate based on the first authentication step and second authentication step;

wherein:

1) the first authentication step (according to claim 29) comprises:

a) obtaining (i.e., receiving) the identification information (i.e., wallet type information (see claim 41)) from the user;

2) the second authentication step comprises (according to claim 34)

a) formulate a query and present the query to the user for a response;

b) (inherently) receive a response from the user;

c) evaluate the response (i.e. compare the response with information in the credit database,

evaluate the response (i.e. compare the response and the application are claiming common subject matter.

(2) is fully disclosed in the patent and is covered by the claims of the patent, would be extended by the allowance of the claims in the application.

Thus, the controlling fact is that patent protection for the device, fully disclosed in and covered by the claims of the patent, would be extended by the allowance of the claims in the application.

Furthermore, there is no apparent reason why applicant was prevented from presenting the claim in the application for examination during the prosecution of the issued patent.

vi. The following two columns are listed for comparing claim 66 of the present application against claim 28 of the patent.

<p>(1) Claim 66 claims a system for interactively authenticating, in real time, a user on a network, the system comprising:</p> <p>(a) an input interface for receiving interactive input from the user;</p> <p>(b) a credit database containing at least one credit file about the user;</p> <p>(c) a processor connected to the input interface and configured to:</p> <ol style="list-style-type: none"> 1) receive a first type of information from the user, wherein the first type of information is wallet type information; 2) formulate and present to the user, in real time, a query based on the first type of information received; 3) receive a response from the user in real time; 4) compare the response with information in the credit database; and 5) provide an indication about the user's identity. 	<p>(2) Claim 28 of Patent (6,321,339) claims system that is for interactively authenticating, in real time, a user on a network, the system comprising:</p> <p>(a) an input interface for receiving interactive input from the user;</p> <p>(b) a credit database containing at least one credit file about the user;</p> <p>(c) a processor connected to the input interface and configured to:</p> <ol style="list-style-type: none"> 1) receive (see claim 29) a first type of information from the user, wherein the first type of information is wallet type information (see claim 41); 2) formulate and present (see claim 34) to the user, in real time, a query based on the first type of information received; 3) receive (see claim 34) a response from the user in real time; 4) compare (see claim 34 for the term "evaluating") the response with information in the credit database; and 5) provide an indication about the user's identity. <p>With regard to the "in real time" limitation recited in the claims of the present application, Patent 6,321,339 specified (at Detailed Description Text - paragraph 111) that the user inputs the first type of information requested into client 110. Data may be queried from the user through textual questions, graphical user interfaces (GUIs), hyper-text markup (HTML) forms or any other suitable mechanisms, either in a real-time interactive environment or through a batch submission. Selection of the input mode may depend upon various factors such as resource loading and availability, business model, user and system traffic and transaction critically.</p>				
<p>b. <u>With regard to claim 67:</u></p> <p>i. The following two columns are listed for comparing claim 67 of the present application against claim 37 of the patent.</p> <table border="1"> <thead> <tr> <th>(1)</th><th>(2)</th></tr> </thead> <tbody> <tr> <td>Claim 67 of the application claims that the system of claim 66, wherein the query is in a multiple-choice format.</td><td>Claim 37 of the patent further claims that the query, being formed, is interactive type and is in a multiple-choice format.</td></tr> </tbody> </table>	(1)	(2)	Claim 67 of the application claims that the system of claim 66, wherein the query is in a multiple-choice format.	Claim 37 of the patent further claims that the query, being formed, is interactive type and is in a multiple-choice format.	
(1)	(2)				
Claim 67 of the application claims that the system of claim 66, wherein the query is in a multiple-choice format.	Claim 37 of the patent further claims that the query, being formed, is interactive type and is in a multiple-choice format.				
<p>c. <u>With regard to claim 68:</u></p> <p>i. The following two columns are listed for comparing claim 68 of the present application against claim 29 of the patent.</p>					

<p>(1) Claim 68 of the application claims that the system of claim 66, wherein the processor is further configured to:</p> <p>(a) retrieve</p> <p>(b) the user's information from the credit database;</p> <p>(c) compare the first type of information with the user's information retrieved from the credit database; and determine</p> <p>(i) a level of correspondence between</p> <p>a) the first type of information and the user's information retrieved from the credit database.</p>	<p>(2) Claim 29 of the patent claims further that the system of claim 28, wherein the first authentication step performed by the processor further comprises:</p> <p>(a) retrieving</p> <p>(b) user information from a data source;</p> <p>(c) comparing the identification information supplied by the user with the user information retrieved from the data source; and determining</p> <p>(i) a level of correspondence between</p> <p>a) the identification information supplied by the user and the user information retrieved from the data source.</p>		
<p>d. <u>With regard to claim 69:</u></p> <p>i. The following two columns are listed for comparing claim 69 of the present application against claim 44 of the patent.</p> <table border="1"> <tr> <td data-bbox="967 346 1128 1018"> <p>(1) Claim 69 of the application claims that the system of claim 66, further comprising</p> <p>(a) a biometric data input device</p> <p>(i) connected to the processor,</p> <p>(ii) wherein the biometric data input device is capable of receiving</p> <p>1) biometric data from the user.</p> </td><td data-bbox="967 1018 1128 2022"> <p>(2) Claim 44 of the patent claims further that system of claim 28, wherein the processor receives biometric input from the user. (from claim 44 of the patent above, it is clearly inherent that the processor in the patented claim 44 comprises a biometric data input device in order to receive biometric data from the user).</p> </td></tr> </table>	<p>(1) Claim 69 of the application claims that the system of claim 66, further comprising</p> <p>(a) a biometric data input device</p> <p>(i) connected to the processor,</p> <p>(ii) wherein the biometric data input device is capable of receiving</p> <p>1) biometric data from the user.</p>	<p>(2) Claim 44 of the patent claims further that system of claim 28, wherein the processor receives biometric input from the user. (from claim 44 of the patent above, it is clearly inherent that the processor in the patented claim 44 comprises a biometric data input device in order to receive biometric data from the user).</p>	
<p>(1) Claim 69 of the application claims that the system of claim 66, further comprising</p> <p>(a) a biometric data input device</p> <p>(i) connected to the processor,</p> <p>(ii) wherein the biometric data input device is capable of receiving</p> <p>1) biometric data from the user.</p>	<p>(2) Claim 44 of the patent claims further that system of claim 28, wherein the processor receives biometric input from the user. (from claim 44 of the patent above, it is clearly inherent that the processor in the patented claim 44 comprises a biometric data input device in order to receive biometric data from the user).</p>		

49. The prior art of record and not relied upon is considered pertinent to applicant's disclosure.

50. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ly V. Hua whose telephone number is (703) 305-9684. The examiner can normally be reached on Monday to Friday, from 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vu Kim can be reached on (703) 305-4393. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ly V. Hua
Primary Examiner
Art Unit 2135

Lyh
April 29, 2004